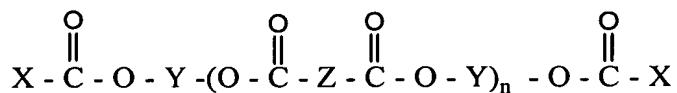


REMARKS/ARGUMENTS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested. Claims 19 and 21-29 have been amended. Claims 30-32 have been added. Support for all amendments and new claims may be found throughout the specification, such as, for example, at page 1, lines 32-36 and at page 2, lines 1-13 and 20-21. No new matter has been added. Upon entry of the above amendments, claims 19 and 21-32, as amended, will be pending.

Claim 19 has been rejected under 35 U.S.C. §102(b) as anticipated by GB 1,122,466 ("GB '466"). Claim 19 has also been rejected under 35 U.S.C. § 102(b) as anticipated by KR 9505692 ("KR '692"). The present invention is directed to composition comprising a metal working fluid comprising an ester having n= 1.5-10.



In contrast, the cited references teach esters having only a single diacid (*i.e.*, n= 1). Specifically, with respect to the GB '466 reference, Applicants respectfully direct the Examiner's attention to the formula at page 3, line 41:



wherein M and M₁ represents monocarboxylic acids, G represents glycol residues, and DA represents a single dicarboxylic acid (*i.e.*, n= 1). Further, GB '466 states at page 3, lines 44-48 that the ester is derived from the reaction of 2 moles of monoacid, 2 moles of diol, and 1 mole of diacid. Here, again, n= 1.

Similarly, with respect to the anticipation rejection based on KR '692, Applicants respectfully assert that KR '692 only teaches a mixture of (i) neopentyl glycol dicaprylate – a diester that comprises no diacid moiety (*i.e.*, n = 0), and (ii) (neopentyl glycol monocaprylate) adipate – a diester that comprises only a single diacid moiety (*i.e.*, n = 1). In this regard, KR '692 only teaches esters that are produced by mixing 1 mole of adipic acid, 2 moles of neopentyl glycol, and 2 moles of caprylic acid. As such, KR '692 fails to teach an ester having n= 1.5-10. Accordingly, Applicants respectfully assert that the claims are patentable in view of the cited references.

Claims 19 and 21-29 have been rejected under 35 U.S.C. § 103(a) as unpatentable over EP 0415778 ("EP '778"). The Examiner acknowledges that EP '778 does not teach with sufficient specificity to anticipate the pending claims, but contends that the working metal fluid of the pending claims is rendered obvious by the teachings of EP '778. Applicants submit that the amendments to the claims are believed to place them in condition for allowance.

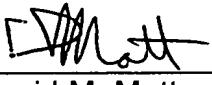
Specifically, the claims have been amended to recite, within the body of the claim, a composition comprising a metal working fluid comprising the ester recited in the pending claims. As is understood in the art, metal working fluids are a specialized class of fluids that can be used as rolling fluids that exhibit superior clean burning and lubricity performance. Metal working fluids, in this regard, are dissimilar to refrigeration oil compositions, in that metal working fluids are not required to perform in very cold environments or during the compression-expansion cycles of refrigeration. Accordingly, to suggest that metal working fluids are analogous to refrigeration oil compositions is to underestimate the multitude of factors and elements involved in formulating effective metal working fluids.

Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

JONES DAY

By: 
David M. Mott
Registration No. 47,808
Direct No. (202) 879-3674

Paul L. Sharer
Registration No. 36,004
Direct No. (202) 879-5481

Intellectual Property Group
51 Louisiana Avenue, N.W.
Washington, D.C. 20001-2113
(202) 879-3939 Telephone
(202) 626-1700 Facsimile

Date: November 17, 2006

WAI-2237782v2
182150 - 600001